

REMARKS

Applicants thank the Examiner for the thorough consideration given the present application. Claims 9, 12-21, and 28-35 are pending. Claims 9, 12, and 13 are currently amended. Claims 32-25 are new. Claims 16 and 32 are the independent claims.

Rejection of Independent Claim 8 Under 35 U.S.C. 102(e):

Independent claim 8 stands rejected under 35 U.S.C. §102(e) as being anticipated by Lyon (U.S. Patent Application Publication 2004/0145342) [hereinafter "Lyon"]. Claim 8 has been cancelled and re-drafted as independent Claim 32. Although the prior art cited in the last Office Action is technically moot since claim 8 has been cancelled, the differences between the prior art and what is specified in Claim 32 is substantially similar to the differences between the prior art and not cancelled Claim 8. In the interest of compact prosecution, Applicants address the shortfalls of the teachings of the prior art to new Claim 32 in a response similar to that which would have been stated in traversal of the rejection of now cancelled Claim 8, as follows:

The Office Action identified an element of Claim 8 that was in need of clarification. As noted in the Office Action, Claim 8 specified a polling mode but not a polling mode circuitry. Applicants have amended the subject matter of Claim 8 by canceling Claim 8 and adding new Claim 32 along the same lines to more clearly specify that polling mode circuitry is claimed as a part of the invention. Applicants represent that the circuitry is inherent from the polling mode function, as disclosed in the disclosure at paragraph [26]. Additionally, Applicants note that the claimed communications unit was originally disclosed in Figure 3, element 318, modem, which is operatively connected to the controller or processor unit. Applicants believe that new Claim 32 clarifies the originally claimed invention and place the invention in a condition for allowance. No new matter is added by these or any other amendments herein.

Applicants note that a certain type of polling is taught in Lyon, at paragraph [0027], wherein Lyon teaches polling "over a separate wireless data channel." In the present invention, the polling is done by the inductive source wherein the inductive energy is turned on or off, thereby avoiding "unwanted flux." See, Disclosure, paragraphs [06] and [07]. Applicants read

Lyons as teaching that the inductive energy remains constantly on, and that the polling is by a separate communications device unrelated to the inductive charger except to notify the charger that there is a battery to be charged. Therefore, Lyon continues to teach the prior art of the inductive charger emitting flux constantly, whereas the present invention specifies that the flux is turned off except when needed.

Rejection of Independent Claim 8 under 35 U.S.C. 102(b):

Independent claim 8, now cancelled and clarified in new Claim 32, also stands rejected under 35 U.S.C. §102(b) as being anticipated by Parks, et al. (U.S. Patent 5,455,466) [hereinafter "Parks"]. Applicants respectfully note in respect to new Claim 32 that Parks also fails to teach or suggest a polling function by the apparatus for receiving inductive energy. As noted above, Applicants believe that Claim 32 clarifies the polling circuitry, and further believe that the claim feature will be found to distinguish over the prior art and place the claim in condition for allowance.

Regarding rejections of dependent claims 10 and 11, Applicants note that these claims have been cancelled and the grounds of rejection are therefore moot.

Rejections under 35 U.S.C. 103(a):

In General

The rejections of claims 9, 12-21, and 28-31 are based on a combination of up to five different patents or patent application publications. It is acknowledged that many patents may be combined in a prior art rejection for obviousness, and Applicants are not arguing that the rejections are not properly based merely on the number of prior art references cited. However, Applicants respectfully submit that in the present case, there is no suggestion, teaching, or motivation to combine the multitude of prior art references as combinations of Lyons, Parks, Stobbe, Wendelrup, Garcia, Gosior, Stephens, and Poletti to result in the invention claimed.

In addition, Applicants further respectfully submit that the piecing together of the claimed invention from bits of many other patents, without a clear showing of some sort of suggestion, motivation, or teaching to combine those elements, is impermissible hindsight. Finally, Applicants argue that although the pieces existed in diverse prior art, it would not have been obvious to one of ordinary skill in the art at the time of the invention to have combined those specific pieces to result in the whole of the invention now claimed.

The Federal Circuit has made it clear that “the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references. Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor’s disclosure as a blueprint for piecing together the prior art to defeat the patentability – the essence of hindsight.” See, *In re Dembicza*k, 50 USPQ2d 1647, 1617 (Fed. Cir. 1999).

The U.S. Supreme Court recently handed down a decision discussing the issue of obviousness. *KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. --- (No. 04-1350, April 30, 2007). The Court reaffirmed the well known *Graham v. John Deere* factors in the determination of obviousness under 35 U.S.C. § 103. See, *Graham v. John Deere Co.*, 383 U.S. 1, 86 S. Ct. 684, 15 L. Ed. 2d 545, 148 USPQ 459 (1966). The KSR Court stated unequivocally that the *Graham* factors “continue to define the inquiry that controls.” *KSR*, 550 U.S. at ---, slip opinion, page 2.

Applicants note that the analysis of the *Graham v. John Deere* factors was reaffirmed as the proper method to determine obviousness. The central discussion was on the “teaching, suggestion, or motivation” (TSM) test that was used by courts and the patent office. The TSM test required a showing of some teaching, suggestion, or motivation in the prior art that would lead one of ordinary skill in the art to combine the prior art elements in the manner claimed in the patent before holding the claimed subject matter to be obvious. The court did not abandon the TSM test, but softened its application, noting as follows:

There is no necessary inconsistency between the idea underlying the TSM test and the Graham analysis. But when a court transforms the general principle

into a rigid rule that limits the obviousness inquiry, as the Court of Appeals did here, it errs.

KSR, 550 U.S. at ---, slip opinion, page 15. The *KSR* Court added the following observation:

As is clear from cases such as *Adams* [*United States v. Adams*, 383 U.S. 39 (1966), a companion case to *Graham*], a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.

KSR, 550 U.S. at ---, slip opinion, page 14. In the recent U.S. Supreme Court case on the issue of obviousness, the Court softened, but did not abandon the “teaching, suggestion, or motivation” to combine elements from different prior art sources, stating:

As is clear from cases such as *Adams* [*United States v. Adams*, 383 U.S. 39 (1966), a companion case to *Graham*], a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. Although common sense directs one to look with care at a patent application that claims as innovation the combination of two known devices according to their established functions, it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed invention does.

KSR, 550 U.S. at ---, slip opinion, pages 14-15.

The Court’s opinion in *KSR* is applicable to this application in that it reinforces the *Graham* analysis and that merely showing that elements in an invention existed in other prior art is not sufficient to conclude that the invention as a whole would have been obvious to one of ordinary skill in the art at the time of the invention. There must be a reason identified to support the legal conclusion of obviousness.

The Office Action identified patents that generally show parts of the invention and concluded thereby that the patent in suit is obvious. As stated by the Federal Circuit:

[M]ere identification in the prior art of each component of a composition does not show that the combination as a whole lacks the necessary attributes for patentability. [Cites omitted.] Rather, to establish a prima facie case of obviousness based on a combination of elements in the prior art, the law requires a motivation to select the references and to combine them in the particular claimed manner to reach the claimed invention.

Eli Lilly and Co. v. Zenith Goldline Pharma., Inc., 471 F.3d 1369, 1379 (Fed. Cir. 2006). Similarly, the Claims Court stated in another recent case:

Subsumed within the Graham factors is a subsidiary requirement articulated by this court that where, as here, all claim limitations are found in a number of prior art references, the burden falls on the challenger of the patent to show by clear and convincing evidence that a skilled artisan would have been motivated to combine the teaching of the prior art references to achieve the claimed invention , and that the skilled artisan would have had a reasonable expectation of success in doing so.

Pfizer, Inc. v. Apotex, Inc., 207 U.S. App. LEXIS 6623, Slip Opinion page 29 (Fed. Cir. case 2006-1261, March 22, 2007). Applicants respectfully submit that the motivations identified in the Office Action are insufficient reasons that it would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the various teachings to result in the invention claimed, as a whole.

Additionally, as argued below, the sum of the cited prior art still fail to teach all of the elements of the claim – specifically the polling circuitry in independent Claim 8 and the polling method in independent Claim 16. Applicants also respectfully submit that the dependent claims are allowable at least based on the allowability of the independent claims

Rejections of Dependent Claims 9, 13, and 15

Claims 9, 13, and 15 are rejected under 35 U.S.C. 103(a) as being obvious over Parks in view of Stobbe (U.S. Patent 6,275,143) [hereinafter "Stobbe"].

Applicants respectfully note that neither Parks nor Stobbe teach or suggest a polling circuitry, as now specified in independent Claim 32, and the references therefore fail to teach or suggest all elements of the claims.

Additionally, Applicants submit that dependent Claims 9, 13, and 15 are allowable at least based on the allowability of the independent claim from which they depend.

Rejection of Dependent Claim 12

Claim 12 is rejected under 35 U.S.C. §103(a) as being unpatentable as obvious over Parks in view of Wendelrup, et al. (U.S. Patent 6,291,966 B1)[hereinafter "Wendelrup"].

Applicants respectfully submit Parks nor Wendelrup teaches or suggests a polling circuitry , as now specified in independent Claim 32, and the references therefore fail to teach or suggest all elements of the claims.

Additionally, Applicants submit that dependent Claim 12 is allowable at least based on the allowability of the independent claim from which it depends.

Rejection of Dependent Claim 14

Claim 14 is rejected under 35 U.S.C. §103(a) as being unpatentable over Parks in view of Garcia, et al. (U.S. Patent 5,963,012)[hereinafter "Garcia"].

Applicants respectfully submit that neither Parks nor Garcia teaches or suggests polling circuitry, as now specified in independent claim 32, and the references therefore fail to teach or suggest all elements of the claims.

Additionally, Applicants submit that dependent claim 14 is allowable at least based on the allowability of the independent claim from which it depends.

Rejection of Claims 16, 17, and 21

Claims 16, 17, and 21 are rejected under 35 U.S.C. §103(a) as being unpatentable as obvious over Garcia in view of Gosior, et al. (U.S. Patent Application Publication 2002/0159434)[hereinafter "Gosior"] in view of Stephens (U.S. Patent 5,734,254) [hereinafter "Stephens"], and in view of Poletti (U.S. Patent Application Publication 2003/0155892)[hereinafter "Poletti"].

The Office Action cites Garcia as teaching or suggesting polling. See Office Action, page 6. Applicants respectfully disagree with this interpretation of Garcia. Garcia teaches a "proximity sensor," which resides on the battery pack. See Garcia, col. 2, lines 29-59. And see col. 2, line 65 through col. 3, line 7. Applicants respectfully submit that a proximity sensor based device waits for a suitable trigger to enter the appropriate range in order to activate the sensor. The triggering device, in the case of Garcia, is taught as the charger unit, however that triggering is the result of a constant generation of a magnetic flux, which is a problem eliminated by the present invention.

In contrast, the present invention specifies polling, which is a periodic method. Applicants note that polling, or "autopolling" was known to one of ordinary skill in the art at the time of the invention as follows:

[T]he process of periodic determining the status of each device in a set so that the active program can process the events generated by each device, such as whether a mouse button was pressed or whether new data is available at a serial port. ...*also called*: polling.

See, Microsoft Computer Dictionary, 5th edition, Microsoft Press, 2002, definition of "autopolling."

The advantage of the present invention over the prior art is discussed in the specification as the elimination of unwanted flux. See disclosure paragraphs [06]-[07]. The unwanted flux is

precisely the constant magnetic flux generated by the source as taught in Garcia. In contrast, in the present invention, the polling activity avoids the unwanted flux problem and the attended issue of inadvertently supplying flux to random metal objects.

Gosior is cited by the Office Action as teaching polling. See Gosior, paragraph [0122]. Applicants respectfully submit that the polling function in the Gosior patent application concerns the timing of peripheral devices in relation to their data downloads from the master device. Although polling by a computer is not a novel invention, Applicants respectfully submit that polling by an inductive energy supply device to initiate communication with a distant device to absorb that inductive energy for the purpose of avoiding unwanted flux is, in fact, new, useful, and non-obvious.

The third and fourth prior arts used in the rejection, Stephens and Poletti, do not teach or suggest a polling circuitry or function.

Rejection of Dependent Claim 18

Claim 18 is rejected under 35 U.S.C. §103(a) as being unpatentable over Garcia in view of Gosior in view of Stephens and in view of Poletti, and further in view of Stobbe.

In view of the allowability of independent Claim 16, as argued above, from which dependent Claim 18 depends, Applicants believe the pending application is in condition for allowance.

Rejection of Dependent Claim 19

Claim 19 is rejected under 35 U.S.C. §103(a) as being unpatentable over Garcia in view of Gosior in view of Stephens and in view of Poletti and further in view of Parks.

In view of the allowability of independent Claim 16, as argued above, from which dependent Claim 19 depends, Applicants believe the pending application is in condition for allowance.

Rejection of Dependent Claim 20

Claim 20 is rejected under 35 U.S.C. §103(a) as being unpatentable over Garcia in view of Gosior in view of Stephens and in view of Poletti and further in view of Wendelrup.

In view of the allowability of independent Claim 16, as argued above, from which dependent Claim 20 depends, Applicants believe the pending application is in condition for allowance.

Rejections of Dependent Claims 28-31

Claims 28-31 are rejected under 35 U.S.C. §103(a) as being unpatentable over Lyon in view of Gosior.

Additionally, in view of the allowability of independent Claim 16, as argued above, from which dependent Claim 18 depends, Applicants believe the pending application is in condition for allowance.

Conclusion

In view of the above remarks, it is believed that claims are allowable.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Michael K. Mutter Reg. No. 29,680 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

Application No. 10/733,820
Amendment dated July 3, 2007
Reply to Office Action of December 12, 2006

Docket No.: 5486-0141PUS1

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.14; particularly, extension of time fees.

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Respectfully submitted,

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